

REMARKS

Applicant has carefully reviewed the Office Action mailed 5/2/2003. By this Amendment, claims 1-31 and 33-35 are cancelled, and new claims 36-51 are added. Claims 32 and 36-51 are pending in this application. It is noted that Applicant has amended and cancelled the above-identified claims solely to advance prosecution of the instant application and to obtain allowance on allowable claims at the earliest possible date. Accordingly, no admission may be inferred from the amendments of claims herein. Applicant expressly reserves the right to pursue the originally filed claims in the future.

In the office action, Claim 32 was rejected under 35 U.S.C. § 102(b) as being anticipated by an affidavit signed by Alexander Shek, February 16, 2001.

Under 35 U.S.C. § 102(b), a person is not entitled to a patent where the claimed invention was in public use more than one year prior to the date of the application for patent. In the present case, Applicant's claimed invention, as recited in claim 32, is a method for forming a plastics article. The Shek affidavit, on the other hand, describes the public sale of certain lithophanes. More particularly, the Shek affidavit states that "[t]he first public sale of a porcelain lithopane ... was in 1991." The Shek affidavit also states that, "[t]he first production and sale of ... 'plastic lithophanes' occurred in 1996." Importantly, however, the Shek affidavit fails to describe any public disclosure of the methods used to manufacture these lithophanes.

When considering whether the activities described by Shek will defeat Applicant's entitlement to a patent under 35 U.S.C. § 102(b), an analogy may be drawn to the facts in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). In Gore, a party

named Budd used a machine manufactured by a party named Cropper to produce and sell PTFE thread seal tape. Id. at 1549. Garlock (the accused infringer) argued that Budd's activities invalidated U.S. Pat. No. 3,953,566 to Gore. Id. The court observed that even assuming "that Budd sold tape produced on the Cropper machine ... and that that tape was made by the process set forth in a claim of the '566 patent, the issue under 102(b) is whether that sale would defeat Dr. Gore's right to a patent on the process inventions set forth in the claims." Id. at 1550. "If Budd offered and sold anything, it was only tape, not whatever process was used in producing it." Id. Accordingly, "[t]here is no reason or statutory basis ... on which Budd's and Cropper's secret commercialization of a process, if established, could be held a bar to the grant of a patent to Gore on that process." Id.

In the present case, the Shek affidavit alleges only the public sale of certain lithophanes. The Shek affidavit does not allege the public disclosure of the method used to produce those lithophanes. "As between a prior inventor who benefits from a process by selling its product but suppresses, conceals, or otherwise keeps the process from the public, and a later inventor who promptly files a patent application from which the public will gain a disclosure of the process, the law favors the latter." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983).

Under 35 U.S.C. § 102(b), a person is not entitled to a patent where the claimed invention was in public use more than one year prior to the date of the application for patent. Because Applicant's claimed invention, as recited in claim 32, is a method and because the Shek affidavit fails to allege the public use of any method, Applicant's claimed invention is not anticipated by the activities described in the Shek Affidavit.

An additional issue to be considered is the effect of the Shek affidavit as a printed publication. Under 35 U.S.C. § 102(b), a person is entitled to a patent unless the invention was described in a printed publication or in public use or on sale more than one year prior to the date of the application for patent. The fact that the Shek affidavit is dated February 16, 2001 indicates that this document is not a writing that predates Applicant's October 1998 priority dates by more than one year.

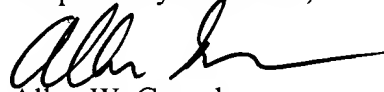
Because the Shek affidavit does not allege that Applicant's invention, as recited in claim 32, was described in a printed publication or in public use or on sale more than one year prior to the application date, Applicant respectfully submits that independent claim 32 is now in condition for allowance. Claims 36-48 depend from Claim 32 and recite additional limitations. Applicant respectfully submits that these dependent claims are also in condition for allowance.

With this amendment, Applicant has submitted new claim 49. Applicant respectfully submits that claim 49 is also not anticipated by the Shek affidavit. In support of this view, Applicant notes that "[r]ejection for anticipation or lack of novelty requires, as a first step in the inquiry, that all the elements of the claimed invention be described in a single reference." In re Spada, 911 F.2d 705 (Fed. Cir. 1990) citing Richardson v. Suzuki Motor Co., 868 F.2d 1226 (Fed. Cir. 1989). In the present case, Applicant's claimed invention, as recited in claim 49 is an article formed of a plastics material in accordance with the method of claim 32. Claim 32 recites the step of moulding an article from a translucent plastics material including a pigmentation. Because the Shek affidavit does not disclose an article molded from a translucent plastics material including a pigmentation, the Shek affidavit does not anticipate Applicant's claimed invention.

Application No. 09/884,237

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Allen W. Groenke

Registration No. 42,608

Customer No. 22859  
Fredrikson & Byron, P.A.  
4000 Pillsbury Center  
200 South Sixth Street  
Minneapolis, MN 55402-1425 USA  
Telephone: (612) 492-7000  
Facsimile: (612) 492-7077

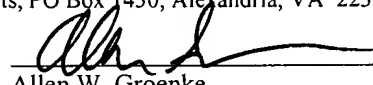
*Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.*

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

10-2-2003

Date of Deposit  
#2843902\1



Allen W. Groenke